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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,543	11/09/2001	Rudolf Pfaendner	PP/1-21105/A/CGM 474/PCT/	8274
324	7590	10/23/2003	EXAMINER	
CIBA SPECIALTY CHEMICALS CORPORATION PATENT DEPARTMENT 540 WHITE PLAINS RD P O BOX 2005 TARRYTOWN, NY 10591-9005			WILSON, DONALD R	
			ART UNIT	PAPER NUMBER
			1713	
DATE MAILED: 10/23/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/037,543

Applicant(s)

PFAENDNER ET AL.

Examiner

Donald R Wilson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-2,9-13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) 11-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,9,10 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

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DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed 9/15/03, has been fully considered with the following results.
2. Applicant's amendment has overcome the objection to the specification and claims, and the objections are withdrawn. However, the amendment to the specification appears to contain new matter as is discussed below. If the changes due to the amendment are withdrawn, the objection to the specification may be reinstated.
3. The rejections under 35 U.S.C. § 101 and § 112, first paragraph, are overcome by the amendment and the rejections are withdrawn.
4. The amendment overcomes the rejection under 35 U.S.C. § 112, second paragraph, and the rejection is withdrawn except in regards to the meaning of polymers having the recited AA, GMA, MAA, MAH or VA functions, and in this regard the rejection is maintained as is discussed below.
5. The amendment overcomes the anticipatory prior art rejection over JP'054, which is withdrawn. However the obviousness rejection based upon JP'054 is not overcome by the amendment and the rejection is maintained as is discussed below.

Previously Cited Statutes

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Objection to New Matter

7. The amendment filed 9/15/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:
 - a. Applicant cites as a basis for the amendment at page 28 of the specification concerning Example B, a foreign language document alleged to show that Lucalen® 3110 MX is a copolymer of ethylene, acrylic acid and butyl acrylate. However, it isn't immediately apparent that such is

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clearly disclosed. If applicant believes that the cited document shows what is alleged, a full English translation of the relevant paragraphs needs to be submitted.

b. The amendment to Claim 1 now recites that the compatibilizer compound is a polymer containing acid groups, anhydride groups, ester groups epoxy groups or alcohol groups, However, it is not seen that the specification shows any enablement for the compatibilizer polymer specifically containing solely ester groups which react with the sterically hindered phenol.

8. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112, First Paragraph

9. ***Claims 1, 2, 9, 10 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.*** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matter in question is that in ¶ (b) of the objection to new matter.

Claim Rejections - 35 USC § 112, Second Paragraph

10. ***Claims 1, 2, 9, 10 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.***

11. Claim 9 is indefinite because it is unclear what polymers are included which have the recited AA, GMA, MAA, MAH or VA functions. If these are polymers made by polymerization of these monomers they would no longer contain said "functions". The basis of this rejection was stated in Detailed Action § 19 of the previous Office Action. Applicant traverses the rejection arguing that the specification makes the meaning of the recited functional groups quite clear, and that they are the reactive groups present on the compatibilizer compound after reaction with the stabilizer component. This is interesting but is not seen to address the merits of the stated rejection. It would seem that perhaps what applicant wants to claim is polymers with acid, anhydride or alcohol functions which are present in copolymers of acrylic acid, glycidyl methacrylate, maleic anhydride or vinyl alcohol. However, this is not the language of the claim, and such polymers would no longer have the unsaturated group functionality as is literally

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expressed in the claim. Applicant's statement that that they are "--- the reactive groups present on the compatibilizer compound after reaction with the stabilizer component", is not understood.

12. Claim 1 is indefinite because "sterically hindered phenols" are a single group. Thus, "selected from the group consisting of the" should be deleted. "Obtained" also needs to be substituted for "obtainable".

13. Claim 10 is indefinite because the copolymers are not the monomers as are listed. This aspect of the rejection can be overcome by deleting in the second line "which is" and substituting "of" therefore. In the last line "an acrylate" needs to be substituted for "acrylates" as a terpolymer would only have three monomeric components.

Claim Rejections - 35 U.S.C. § 103(a)

14. ***Claims 1, 2, 9, 10 and 15 are rejected under 35 U.S.C. 103(a) as obvious over JP'054 in view of Examiner's Notice of Admissions by Applicant.*** The basis of this rejection was stated in Detailed Action § 26-30 of the previous Office Action.

15. First, as requested by applicant, a copy of an English translation of JP'054 by the Patent Office is attached.

16. Applicant traverses the rejection arguing that the Examiner has used the instant application as a blueprint. However, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Applicant's argument is not deemed to be persuasive because the Examiner has only used knowledge which was within the level of ordinary skill at the time the claimed invention was made has been used.

17. Applicant further argues that the polymeric stabilizer of JP'054 is only used to stabilize polypropylene filament. This is not deemed to be persuasive for several reasons. First, it is well established that a *prima facie* case of obviousness (for a composition) does not require the solution of the same problem or recognition of the same advantages as the applicant's invention. *In re Dillon* 16

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USPQ2nd 1897 (CAFC, en banc, 1990), which overrules *In re Dillon* 13 USPQ 2nd 1337 and *In re Wright* 6 USPQ 2nd 1959. Further, the fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious." *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In regards to the stabilizer only being useful for polypropylene fiber, the reference clearly teaches its use as an effective stabilizer for polyolefins and for polyamides. (See p. 4 of the attached translation, 4th and 5th full paragraphs.) Thus, it would clearly have been envisaged to use it in other polyolefins as well as polyamides. As was previously stated,

"Applicant has also admitted that the preparation and use of polymer blends such as the elected specie of a polyethylene/nylon-6 blend is known. It would have been considered routine and well known to use stabilizers in such polymer blends for their intended purpose. It would also have been obvious to one of ordinary skill in the art to use the stabilizers taught by JP'054 in polyethylene/nylon-6 blends with an expectation of improved performance over lower molecular weight stabilizers in terms of permanence, i.e., lack of bleeding, lower extractability etc.. This is particularly so as JP'054 teaches their use in the individual components of such a blend."

Art of Interest/Technological Background

18. As was previously noted the following references are considered pertinent to applicant's disclosure, and may be used in the rejection of non-elected species of the claimed invention should they come under consideration.

19. JP'055 discloses the stabilization of polyolefins with stabilizers prepared from acrylic acid copolymers and hindered p-glycidyloxyphenols.

20. JP'782 discloses the stabilization of polyolefins with ethylene-vinyl acetate copolymers which have been transesterified to produce hindered phenol esters.

21. JP'719 discloses the stabilization of polyolefins by grating with carboxylic acid containing monomers followed by reaction with the elected specie of hindered phenol.

22. MacLeay discloses the stabilization of polymers or polymer blends with stabilizers prepared by the reaction of hydrazido substituted hindered phenols with cyclic anhydride containing polymers. EP'996 has a similar disclosure and also includes reactions with amine substituted hindered phenols.

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Popisil (Advances in Science 101) discloses a number of polymeric stabilizers of hindered phenols used as stabilizers in conventional polymers (see formulas # 216, 221a, 228, 229, 242, 243, 247, 248, 254, pp.130 to 145.

Action Is Final

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

24. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

25. This application contains Claims 11-13 drawn to an invention nonelected with traverse in Paper No. 5 & 9. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

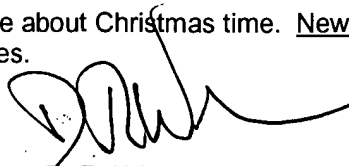
Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D.R. Wilson whose telephone number is 703-308-2398 (571-272-1113).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 703-308-2450 (571-272-1114). The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications. The unofficial direct fax phone number to the Examiner's desk is 703-872-9029 (571-273-1113).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351.

The Examiner is expected to move to the new Office about Christmas time. New telephone numbers known to the Examiner are indicated in parentheses.


D. R. Wilson
Primary Examiner
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attach: English translation of JP 44-32054 (PTO 03-3895